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JAN 31 2005

In re Application of :
Ainsworth et al. :
Application No.09/746,746 :
Filed: December 22, 2000 :
Attorney Docket Number: ACS 54804 :
Title of Invention: Intravascular Stent :

OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition filed August 18, 2004, under 37 CFR 1.137(a) and in the alternative under 37 CFR 1.137(b) to revive the above-identified application.

The petition to revive under 37 CFR § 1.137(a) is **DISMISSED**.

The petition to revive under 37 CFR § 1.137(b) is **GRANTED**.

This above-identified application became abandoned for failure to timely file a proper reply to a final Office Action pursuant to 37 CFR §1.113. The final Office Action was mailed on December 22, 2003 and set a three (3) month shortened statutory period for reply. An amendment was submitted on February 17, 2004. In response to the amendment an Advisory Action was mailed on June 25, 2004 indicating the amendment submitted on February 17, 2004 did not place the application in condition for allowance. Accordingly, this application became abandoned on June 23, 2004. A Notice of Abandonment was mailed on September 8, 2004.

PETITION TO REVIVE UNDER 37 CFR § 1.137(a)

A grantable petition under 37 CFR § 1.137(a) must be accompanied by:

- (1) the required reply.¹

¹ In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

- (2) the petition fee,
- (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and
- (4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

The instant petition lacks items (3).

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 37 CFR §1.137(a).

The Office may revive an abandoned application if the delay in responding to the relevant outstanding office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 CFR § 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" is applicable to ordinary human affairs, and requires no more greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case by case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2D 1130 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).² Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.³

Petitioner asserts the application was unavoidably delayed because the ability to prosecute the application by the required date was not feasible given the date the

²See MPEP 711(c)(III)(c)(2) for a discussion of the requirements for a showing of unavoidable delay.

³Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

advisory action was mailed. Petitioner further argues the abandonment should be withdrawn.

Petitioner's arguments have been considered but they are not persuasive. Petitioner was informed in the Final Office Action and the Advisory Action that the statutory time period for reply could not be extended beyond the six months from the mailing of the Final Office Action. Pursuant to 37 CFR 1.116 (b), the admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination from termination. Further MPEP 711.03 (c) is clear that an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, when the applicant simply permits the maximum extendable statutory period for reply to expire while awaiting a notice of allowance or other action.

Accordingly, petitioner has failed to provide sufficient arguments that warrant the finding of unavoidable delay within the meaning of 37 CFR 1.137(a). Further petitioner has failed to establish the facts presented require the abandonment of the application to be withdrawn.

PETITION TO REVIVE UNDER 37 CFR 1.137(b)

In the alternative, petitioner has requested the above petition be treated under 37 CFR 1.137(b).

The statement of unintentional delay presented in the petition does not comply with the current rule. Pursuant to 37 CFR 1.137(b)(3) a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" is required. However, the statement presented will be accepted and construed as the statement required by 37 CFR 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The requirements for the filing of a grantable petition under 37 CFR §1.137(b) have been met. This Petition is hereby Granted.

Pursuant to petitioner's request deposit account 06-2425 will be charged the \$1370 unintentional petition fee.

This application is being forwarded to Technology Center 3700 for further processing of the Request for Continued Examination (RCE) and the amendment submitted on with the instant petition.

Telephone inquiries should be directed to the undersigned at (571) 272-3215.



Charlema R. Grant

Petitions Attorney

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